

## **REMARKS**

### **Status of Claims**

Claims 1-48 are currently pending after entry of this amendment. Claims 1-48 stand rejected. Claims 49-62 have been withdrawn as a result of a restriction requirement. Claims 1, 18, and 39 have been amended. Entry and consideration of these amendments is respectfully requested.

### **Amendments to the Specification**

The specification has been amended to correct a typographical error (p. 13, line 23 through p. 14, line 7) and to reduce the likelihood of any misreading of the description (p. 21, lines 1-23). No new matter has been added.

### **Claim Objections**

Applicants acknowledge the inadvertent mis-numbering of the claims as filed. The current listing of the claims reflects the Examiner's re-numbering of the claims from claim 8 through claim 62.

### **Restriction Requirement**

Pursuant to Examiner's restriction requirement, claims 49-62 have been withdrawn from further consideration. Applicants confirm the election of Group I including claims 1-48. In view of this restriction requirement, Applicants retain the right to present claims 49-62 in a divisional application.

### **Support for Amendments**

No new matter is believed to have been added by the current amendments.

Support for the amendments to claims 1, 18, and 39 can be found in FIGS. 2 and 13, and in the specification at Page 24, lines 14-30.

### **Rejections under 35 U.S.C. § 102**

The present invention includes a method of making wet rolls comprising providing a web of material, applying a wetting solution to the web to create a wet web, breaking the wet web, and then winding the wet web into a roll. Notably, the web of the present invention is wetted before it is broken.

As shown in FIG. 6 and as described on page 16, line 25 through page 17, line 6, during the described process the wetting solution 134 is applied upstream of the point at which the winding apparatus breaks the wet web and forms a leading edge 92. (See FIG. 13 and page 24, lines 20-22.) While the web may be wetted by a variety of different means, see FIGS. 4-9, it is always wetted before it is broken by the winding apparatus. This allows the entire roll, including the very center of the cigarette 86 to be treated evenly with wetting solution (See FIG. 13).

### **Rejections over Cole**

Claims 1, 3-7, 12-15, and 18 were rejected under 35 U.S.C. § 102(e) as anticipated by Cole (US Pat. No. 6,444,214).<sup>1</sup> The Office Action asserts that Cole discloses providing a web of material and applying a wetting solution to the web, and that the wet web can be packaged in a roll, which may be coreless. The Examiner does not assert that Cole discloses winding the wet web, but asserts that packaging the wet web as a roll would inherently require winding the wet web into a roll.

The rejection of the claims as anticipated by Cole is respectfully traversed. Applicants point out that the Examiner has not provided the rationale or evidence required to support the assertion that Cole inherently winds a wet web. As noted in MPEP 2112, with reference to *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999):

“ ‘Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” [emphasis added]

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<sup>1</sup> Although the claims initially listed in section 9 on page 4 of the Office Action include only claims 1, 3-7, 12-15 and 18, the last paragraph on page 4 cites claim 2. As it appears the Examiner intended to include claim 2 in this section, Applicants have addressed claims 1-7, 12-15 and 18 with respect to the anticipation rejection over Cole.

As the Examiner has not provided any rationale or evidence beyond a conclusory statement of inherency, a *prima facie* case of anticipation has not been made.

Moreover, Applicants' specification refutes any assumption that a wet roll is necessarily made by winding a wet web. As noted on page 1, line 31 to page 2, line 2, wet wipes have typically been manufactured as a roll of dry sheets, and the roll is then soaked in a wetting solution. The Cole reference does not indicate whether the web was wetted in a wetting solution before or after being wound into a roll, and it does not necessarily follow that such articles are wound after they are wetted.

Cole does not disclose each and every element of the claims, nor has the Examiner shown that Cole inherently discloses any of the claim elements. Accordingly, a proper *prima facie* case of anticipation of claims 1-7, 12-15, and 18 by Cole has not been made, and Applicants respectfully request that this rejection be withdrawn.

### **Rejection over Perini**

Claims 1, 12, 14, 17, 31-34, and 39-40 were rejected under 35 U.S.C. § 102(a) as anticipated by Perini (WO 01/40090 A2). The Office Action asserts that Perini discloses a method of making wet rolls comprising the steps of providing a web of material, applying a wetting solution to the web to produce a wet web, and winding the wet web using a roll-forming pocket to make wet rolls using the apparatus illustrated in FIG. 1.

The rejection of claims 1, 12, 14, 17, and 39-40 has been obviated by appropriate amendment, and the rejection of claims 31-34 is respectfully traversed. As amended, independent claims 1 and 39 recite a method which includes breaking the wet web after applying a wetting solution to the web to produce a wet web. Independent claim 31 recites a method which includes the step of breaking the web after it has been wetted and forming a cigarette from the leading edge of the break. Therefore, all of the independent claims under examination include breaking a web that is wet.

In contrast, Perini discloses that it is critical that the web of material is dry when it is broken. It is not until after the breaking or interruption zone that the web is wetted. In fact, on Page 8, line 25 through page 9, line 4, Perini teaches that the "changeover" of a

broken web forming a new roll must be performed with a dry sheet, noting that the changeover:

"... is caused to take place with material which is substantially dry. The presence of moisture or liquid impregnating the material would make the changeover difficult or would in some cases even render it impossible, with the consequence that the winding process could not be performed continuously." [p. 8, line 32 – p. 9, line 4]

To ensure that the changeover zone remains dry, Perini discloses that nozzles spraying dry air can be located upstream from the interruption zone to remove any moisture from the web. Page 9, lines 11-15. Thus, Perini does not disclose winding a wet web into a roll, where the web is wet when it is broken to finish one roll and begin another.

Perini cannot anticipate independent claims 1, 31, and 39 since it does not disclose each and every element of the claims. Claims 12, 14, 17, 32-34, and 40, which depend from claims 1, 31, and 39, are thus also not anticipated. Accordingly, claims 1, 12, 14, 17, 31-34, and 39-40 are not anticipated by Perini, and Applicants respectfully request that this rejection be withdrawn.

### **Rejections over Abba**

Claims 1-2, 5-7, and 15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Abba (EP 256,950). The Office Action asserts that Abba discloses providing a web of material, applying a wetting solution to the web, perforating the web, and packaging the continuous wet web into a roll. The Examiner does not assert that Abba discloses winding the wet web, but asserts that packaging the wet web as a roll would inherently require winding the wet web into a roll.

The rejection of the claims as anticipated by Abba is respectfully traversed. Applicants point out that the Examiner has not provided the required rationale or evidence to support the assertion that Abba inherently winds a wet web. As noted above with respect to the anticipation rejection over Cole, the Examiner has not provided any rationale or evidence beyond a conclusory statement of inherency, and thus a *prima facie* case of anticipation has not been made. Abba discloses merely that a stack of moist wipes may be in a container, and that the stack may be a rolled collection of sheets. Col. 2, lines 5-8. The Abba reference does not indicate whether

the web was wetted in a wetting solution before or after being wound into a roll, and it does not necessarily follow that such articles are wound after they are wetted. With respect to claim 15, Abba does not disclose, nor has the Examiner asserted that Abba discloses, a method wherein the web comprises a water-dispersible binder.

Abba does not disclose each and every element of the claims, nor has the Examiner shown that Abba inherently discloses any of the claim elements. Accordingly, a proper *prima facie* case of anticipation of claims 1-2, 5-7 and 15 has not been made, and Applicants respectfully request that this rejection be withdrawn.

### **Rejections under 35 U.S.C. § 103**

#### **Rejections over Perini**

Claims 2-11, 16, 18-30, 36-38, and 41-48 were rejected under 35 U.S.C. § 103(a) as obvious over Perini.<sup>2</sup> For independent claim 18, the Office Action asserts that Perini discloses controlling the draw of the web, perforating the web, positioning the web adjacent a wetting apparatus and applying a wetting solution, and further asserts that the web of material is inherently provided from a source and that the add-on level is an obvious optimization. For dependent claims 2-11, 16, 19-30, 35-38 and 41-48, the Office Action asserts that aspects of the claimed method such as wetting solution add-on, speed of travel of the web, lack of contamination, and salt content are obvious variations or optimizations of the Perini process.

The rejection of claims 35-38, which depend from independent claim 31, is respectfully traversed. The rejection of claims 2-11 and 16, which depend from independent claim 1, claims 18-30, and claims 41-48, which depend from claim 39, has been obviated by appropriate amendment. All of the independent claims under examination include breaking a web that is wet, and thus the dependent claims also

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<sup>2</sup> Although the claims initially listed in section 13 on page 6 of the Office Action include only claims 2-11, 16 and 18-30, the remainder of the section further cites claims 35-38 and 41-48. Further, the first paragraph of section 14 on page 8 of the Office Action refers to the application of the Perini reference to claims 1-12, 14, 16-19 and 21-48. Applicants remarks regarding the rejection over Perini under 35 U.S.C. § 103(a) thus address claims 2-11, 16, 18-30, 35-38 and 41-48.

include this claim recitation. As noted above with respect to the anticipation rejection over this reference, Perini specifically requires that the web is dry when it is broken. Moreover, Perini teaches away from breaking a wet web, stating that breaking a web after it is wetted would cause difficulty in the winding process. There can be no suggestion or motivation to modify the Perini method to include the breaking of a wet web in view of these teachings in the reference. Accordingly, Perini does not teach or suggest each and every element of claims 2-11, 16, 18-30, 35-38, and 41-48, and Applicants respectfully request that this rejection be withdrawn.

### **Rejections over Perini in combination with Cole**

Claims 13, 15, and 20 were rejected under 35 U.S.C. § 103(a) as obvious over Perini in view of Cole. The rejection of claims 13, 15 and 20 is respectfully traversed, as Cole is not a proper reference under 35 U.S.C. § 103. The present application and U.S. Patent. No. 6,444,214 were, at the time the invention of the present application was made, commonly owned by Kimberly-Clark Worldwide, Inc. Accordingly, under 35 USC § 103(c), U.S. Pat. No. 6,444,214 cannot be used, alone or in combination with other references, in a rejection under 35 U.S.C. § 103.

### **Rejections over Abba**

Claims 3-4, 8-11, and 16-17 stand rejected under 35 U.S.C. § 103(a) as being obvious over Abba. The Office Action asserts that Abba discloses wetting solution add-on levels that overlap the ranges cited in claims 3-4, and that the recitations of claims 8-11 and 16-17 are obvious variations or optimizations as noted in the rejection over Perini under 35 U.S.C. § 103(a). Applicants note for the record that claim 17 was not included in the obviousness rejection over Perini and may have been inadvertently included in this rejection over Abba.

The rejection of claim 3-4, 8-11 and 16-17 is respectfully traversed. These claims depend from independent claim 1, and thus include the winding of a wet web. The disclosure of wetting solution add-on levels in Abba is immaterial, as the reference does not teach or suggest winding a web that contains these add-on levels. As noted above with respect to the anticipation rejection over this reference, Abba does not

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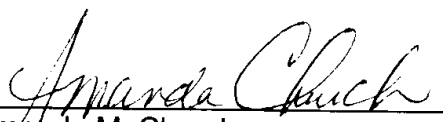
disclose winding a wet web. Moreover, the Examiner has not provided any suggestion or motivation to wind a wet web into a roll. Abba does not teach or suggest each and every element of claims 3-4, 8-11 and 16-17, and Applicants respectfully request that this rejection be withdrawn.

### SUMMARY

Pending Claims 1-48 as amended are patentable. Applicants respectfully request the Examiner grant early allowance of this application. The Examiner is invited to contact the undersigned attorneys for the Applicant via telephone if such communication would expedite this application.

Also submitted at this time is a Petition for Extension of Time for one (1) month.

Respectfully submitted,

  
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